1631

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of : Group Art Unit: 1631

Grassy et al. : Examiner: Zeman, M

Application No. 09/359,181

Filed: July 22, 1999

For: METHOD FOR THE PROVISION, IDENTIFICATION AND DESCRIPTION OF MOLECULES CAPABLE OF EXHIBITING A DESIRED BEHAVIOUR, MORE PARTICULARLY IN THE PHARMACEUTICAL SECTOR, AND MOLECULES OBTAINED BY SAID METHOD

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Paige R. Zeitz

RESPONSE

Sir:

In response to the Office Action dated January 31, 2001, reconsideration is respectfully requested in view of the following comments. In the restriction and election requirement of September 15, 2000, the examiner identified claims 1, 2 and 12-20 as a distinct invention from the remaining claims. The examiner stated that such claims were drawn to "computer aided methods for identifying molecules having various properties, wherein a static filter is applied to a data set". These claims were the claims of Group I.

It is respectfully observed that original claim 1 in fact recited the application of a static filter, *and/or* a dynamic filter. It is observed that the examiner stated that inventions drawn to the use of a dynamic filter alone, or a static filter followed by a dynamic filter, were different inventions from that of group I.

In the response filed on November 16, 2000, applicants stated: "the applicants elect, with traverse, the claims of Group I (which refer to static filters)". See the first paragraph of the Remarks at page 4 of Applicants Response of November 14, 2000. This is believed to be fully responsive to the election requirement. Accordingly, the Examiner's assertion that Applicants' failed to elect an invention for prosecution should be withdrawn.

Furthermore, in order to better reflect the categorization of inventions proposed by the

Examiner, applicants amended claim 1 to recite only the step of applying a static filter. This was to focus the claim on the step identified by the Examiner as the invention of Group I, the rest of the claim having been deemed by the Examiner to lie in Group II and Group III.

It is further submitted that the amendment of claim 2 does not, as now asserted by the Examiner, place the claim into Group III. Claim 2 is dependent upon claim 1. It is surely an indisputable principle of patent law that where an independent claim is examined and found patentable over the art, then a true dependent claim is equally patentable over the art, since it by definition contains the patentable feature of the main claim.

Furthermore, even though original claim 1 recited the option of using both a static and a dynamic filter, there was no objection to this recitation of using both a static and dynamic filter in the examiner's restriction and election requirement of September 15. It is thus improper to raise a fresh objection at this stage. Indeed, even the Examiner represented in the present Office Action that "The Examiner will not re-restrict the application." See page 2 of the present Office Action.

It is furthermore perfectly proper to amend dependent claims, in this case claims 4 and 5, to refer to an elected main claim. As argued above, the patentability of such claims can, in the first instance, be considered in the light of the main independent claim.

The Examiner has also stated that the applicants have failed to elect a species. In the action of September 15 the Examiner set out six species (a) to (f), of which (f) was defined as immunomodulators. The Examiner's attention is again drawn to Applicants' statement under the first paragraph of the Remarks on page 4 of the response of November 16, where it is stated: "In addition, the applicants elect "immunomodulators" in response to the species requirement."

In summary Applicants did not fail to elect a group. The response of November 16, 2000, contains an explicit election, with traverse, of Group I. The claims as amended all fall within Group I as identified by the Examiner, to the extent that they are all dependent upon a main claim reciting the invention identified as the Group I invention. Applicants did not fail to elect a species. Indeed, the response of November 16, 2000, contains an explicit election of a species.

Respectfully submitted,

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